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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,636	03/03/2000	Hideyuki Makitani	35.G2546	5830

5514 7590 07/13/2005

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EXAMINER

POON, KING Y

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/518,636

Applicant(s)

MAKITANI, HIDEYUKI

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005 and 25 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,7,15,16,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,7,15,16,26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/25/2005 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 6, 15, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berke (US 5,940,187) in view of Shung (US 4,924,494) and Ishikawa (US 6,262,805).

Regarding claims 1, 6: Berke teaches an telecommunication apparatus (20a fig. 1, column 5, lines 10-15) connected to a plurality of image forming apparatuses (16b and 10, fig. 1, note) via a network (14, fig. 1) for transmitting an image signal (facsimile message, column 5, lines 30-35) representing an image that has been read to one of the plurality of image forming apparatuses (12, fig. 1, note), said telecommunication station comprising: generation means for generating an image signal (e.g., facsimile

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message, fig. 10, fig. 2 fig. 3); selection means (the control device/ program of the fax machine that allows user to enter a desired destination, column 10, lines 40-50) for selecting one of the plurality of image forming apparatuses for receipt of the generated image signal; determination means (the control or the program of the telecommunication system that determines to inform the user that identification is required from the message received by the certifying system, column 8, lines 50-55) for determining whether or not the selected image forming apparatus requests input of management information relating to a user; input means (the device or control that allowed the user to enter the identification (column 8, lines 2-5) for inputting the management information in accordance with a result of the determination by said determination means; transmitting means (the transmission program of fax machine 20, column 8, lines 1-5) for transmitting the inputted management information to the selected image forming apparatus; reception means (the receiving program of the fax machine or receiving device that received the control number, column 8, lines 65-68, and the prompts of column 9, lines 45-46) for receiving a result of authenticating the transmitted management information from the selected image forming apparatus control means (the control device of 16a that controls the transmit of message 54, column 9, lines 45-55) for controlling transmission of the generated image signal to the selected image forming apparatus in accordance with the received result of the authentication of the transmitted management information from the selected image forming apparatus.

Berke teaches apparatus 16 contains a fax machine (fax machine).

Berke does not teach the fax machine has an image reading device.

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Shung, in the same area of fax, teaches it is well known in the art that a fax machine has a scanning device (column 1, lines 15-25).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Berke's communication apparatus to include an image reading unit in the fax device of the communication apparatus such that the fax device would function as a conventional fax device as expected by fax users.

Note: Column 5, lines 45-55 Berke teaches the certifying system converts fax signal to bitmap, and that the certifying apparatus has fax hardware. Ishikawa teaches the bit map generated by the fax hardware, inherently, is an image to be printed by a printer (column 19, lines 25-26, fig. 1). Therefore, the certifying system is an image forming apparatus by forming a bit map image from fax signal.

Moreover, Shung, column 1, lines 15-25, teaches it is well known in the art that a fax hardware includes a printer.

Regarding claim 15: Shung teaches a fax machine is controlled by processor, column 1, lines 15-25, column 2, lines 23-30; it is well known in the art that a processor is controlled by a program stored in a computer readable memory. Please also see claim 1.

Regarding claim 27: Berke teaches wherein the management information includes at least a user ID for the authentication determination at the selected image forming apparatus (column 7, lines 60-68, column 8, lines 50-55).

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4. Claims 2, 7, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berke (US 5,940,187) in view of Shung (US 4,924,494) and Ishikawa (US 6,262,805) as applied to claims 1, 6, 15 above, and further in view of Ostuka (US 5,579,126).

Regarding claims 2, 7, 16: Berke does not mention that the control means compresses the image signal prior to transmitting the image signal.

Ostuka, in the same area of transmitting fax, teaches it is well known in the art to compresses the image signal prior to transmitting the image signal (column 8, lines 20-26).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Berke's communication apparatus to include the control means compresses the image signal prior to transmitting the image signal to shorten the transmitting time as well as to conserve valuable network bandwidth.

5. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berke (US 5,940,187) in view of Shung (US 4,924,494) and Ishikawa (US 6,262,805) as applied to claim 1 above, and further in view of Kuo (US 5,295,181)

Regarding claim 26: Berke does not teaches wherein the selection means selects the image forming apparatus according to the generated image signal.

Kuo, in the same area of fax, teaches it is well known in the art that selection means selects the image forming apparatus according to the generated image signal (column 5, lines 5-20).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Berke's communication apparatus to include the selection means selects the image forming apparatus according to the generated image signal.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Berke's communication apparatus by the teaching of Kuo because: it would have allowed the system to automatically transmit images to destination, it would have reduce the work of users; and it would reduced errors through automation.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 2, 6, 7, 15, 16, 26 and 27 have been considered but are moot in view of the new ground(s) of rejection. Please see detailed office action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 8, 2005

A handwritten signature in black ink, appearing to read 'King Y. Poon', with a stylized flourish at the end.

**KING Y. POON
PRIMARY EXAMINER**